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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,648	03/15/2002	William A. Elmer	8588.12RE	7382

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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/098,648	ELMER, WILLIAM A.	
	Examiner	Art Unit	
	Brian K. Green	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A ~~SHORTENED~~ STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

~~Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.~~
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-26 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

While there is a stay of the concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed or suspended because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

The patent sought to be reissued by this application is involved in litigation. Any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

The patent owner filed an amendment on Aug. 22, 2005 that include changes to the specification, claims, and drawings which require a supplemental reissue oath/declaration to be filed. See MPEP 1414.01.

Claims 1-26 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plastic coating defined in claims 12,17, and 26 and the beveled head defined in claims 21 and 24 must be shown or the feature(s) canceled from the claim(s). In figure 1A, the patent owner labels the outer layer as the metal housing (134) including a lip (136). If the outer layer is actually the plastic coating than the patent owner needs to direct the lead lines for numerals 134 and 136 to the proper elements and to provide a numeral and lead line for the plastic coating. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The amendment filed September 13, 2005 with regard to changes to the specification are improper since they do not comply with 1.173(b)(1). The subject matter removed from the specification should not be shown in brackets since this subject matter did not originally exist in the original patent. Further, the subject added to the specification must always be underlined, i.e. subject matter was added to the specification on April 5, 2004, and all of this added subject matter is not underlined in the Sept. 13, 2005 amendment as required.

Claim Rejections - 35 USC § 112

Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, lines 3-4, "below a remaining portion of the base around each receptacle" is indefinite since it is not clear what the patent owner is trying to state and further if the patent owner is trying to relate the remaining portion of the base not associated with the receptacles than the language is misdescriptive since the word "around" suggests that the remaining portion of the base extends about/around each receptacle which is inaccurate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3, and 19-25 are rejected under 35 U.S.C. § 103 as being unpatentable over European Patent No. 415,194 in view of George (U.S. Patent No. 4,052,806).

European Patent No. '194 shows in figures 1-6 an advertising sign comprising an advertising member (1) having a base (3,114), plural magnets (112), and means (115,116,117) for pivotally attaching each magnet to the base wherein the pivotal means includes a flexible sleeve (115). European Patent No. '194 shows a fastener that extends through the magnet, flexible sleeve and into the base, see fig. 6. European Patent No. '194 does not disclose forming the advertising member with ends and sides. George shows in figures 1-4 an illuminated sign that is secured to the roof of a vehicle that comprises a base, ends, and sides. In view of the teachings of George it would have been obvious to one in the art to modify European Patent No. '194 by forming it in the shape taught by George since this is just one of a wide range of conventional shapes that the sign could be formed into in order to create an aesthetically pleasing display. In regard to claim 19, EP '194 shows that the base includes a unitary sheet (3) and when the base of EP '194 is modified in view of George it would be rectangular in shape. EP '194 shows in figure 4 the idea of placing one of the magnets in each of the corners of the base. EP '194 does not disclose whether the sheet is made from plastic. George discloses in column 4, lines 1-10 the idea of making the advertising sign from a plastic material. In view of the teachings of George it would have been obvious to one in the art to modify EP '194 by making the base from plastic since this would allow the base to be made in a easier, faster, and lighter manner. In regard to claim 20, EP '194 shows in figure 6 a fastener (117) and flexible sleeve (115). In regard to claim 21, EP '194 does not disclose making the head of the fastener beveled. It would have been an obvious matter of design choice to make the head of the fastener beveled shaped since there appears to be no advantage to making the head beveled and the shape of the fastener head taught by EP '194 would work equally well. In regard to

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claim 22, EP '194 discloses in column 2 the idea of placing a light source within the member (1) and making the member (1) translucent. In regard to claim 23, EP '194 does not disclose whether the lighting assembly extends lengthwise along the rectangular base. George shows in figure 1 the idea of making the light assembly (11) extend along the length of the base. In view of the teachings of George it would have been obvious to one in the art to modify EP '194 by extending the light source along the length of the base since this would allow the sign to be illuminated in a better and more even manner. In regard to claim 24, the base is formed of a unitary sheet (3) and when the base of EP '194 is modified in view of George it would be rectangular in shape. EP '194 shows in figure 4 the idea of placing one of the magnets in each of the corners of the base. EP '194 shows in figure 6 a fastener (117) and flexible sleeve (115). EP '194 does not disclose making the head of the fastener beveled. It would have been an obvious matter of design choice to make the head of the fastener beveled shaped since there appears to be no advantage to making the head beveled and the shape of the fastener head taught by EP '194 would work equally well. The base includes a portion (sheet 3) that is recessed with respect to the rest of the base (114). In regard to claim 25, as broadly defined, the upper surface each of the magnets (112) is considered to be "recessed toward the base" and the opposing bottom of the magnet extends below the portions of the adjacent sides and adjacent end.

Claims 13-17 are rejected under 35 U.S.C. § 103 as being unpatentable over European Patent No. 415,194 in view of George as applied to claims 2 and 3 above, and further in view of Podoloff (U.S. Patent No. 3,245,165).

In regard to claims 13-16 European Patent No. 415,194 in view of George disclose the applicant's basic inventive concept except for surrounding each magnet with a magnet receptacle. Podoloff shows in figures 1-5 a sign secured to a vehicle comprising magnetic members (12) each surrounded by a magnet receptacle (14). Podoloff also shows that the housing (14) extends below the magnetic member (12). In view of the teachings of Podoloff it would have been obvious to one in the art to modify European Patent No. 415,194 by placing each magnet member in a receptacle since the receptacle would help to prevent scratching of the metal panel (roof of vehicle) to which the advertising sign is attached. In regard to

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claims 14 and 15, the magnet receptacle of Podoloff, when attached to the magnets of EP '194, would extend along a portion of an adjacent side and end. In regard to claim 17, EP '194 does not disclose placing a plastic coating across the bottom surface of each magnet. Podoloff shows in figures 2-5 that there is a flexible layer (36) extending below each magnet. In view of the teachings of Podoloff it would have been obvious to one in the art to modify European Patent No. 415,194 by placing a coating over the bottom surface of each magnet since the coating would help to prevent scratching of the metal panel (roof of vehicle) to which the advertising sign is attached. Podoloff does not disclose making the layer from a plastic material. It is considered within one skilled in the art to make the layer out of a plastic material since this would allow the layer to be made in an easier and less expensive manner.

Response to Arguments

Applicant's arguments filed Sept. 13, 2004 have been fully considered but are not persuasive.

The patent owner argues that Mrs. Elmer's original and supplemental affidavits clearly demonstrate commercial success under to controlling CAFC decisions. The examiner disagrees since the evidence provides no data concerning whether the amount of sales of the product sold represents a substantial share in the market. The courts have indicated that evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. See *In re Huang*, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *Cable Elec. ProdsI, Inc. v. Genmark, Inc.*, 770 F.2d at 1026-27, 226 USPQ at 888. Even assuming that the patent owner had sufficiently demonstrated commercial success, that success is relevant in the obviousness context only if it is established that the sales were a direct result of the unique characteristics of the claimed invention, as opposed to other economic and

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commercial factors unrelated to the quality of the claimed subject matter. See cable Elec., 770 F2d at 1027, 226 USPQ at 888. The patent owner must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. See Ex parte Remark , 15 USPQ2d 1498, 1502-03 (Bd. Pat. App. & Inter. 1990). Furthermore, the patent owner has failed to submit sufficient factual evidence that would demonstrate the nexus between the sales and the claimed invention. In sum, the patent owner has not provided sufficient evidence that a nexus exists between any commercial success and the novel features claimed in the application.

The patent owner argues the member 115 in EP '194 is not a sleeve. The examiner disagrees since the member (15) in EP '194 can be considered a "sleeve" since it is an "encasement into which an object fits".

The patent owner argues that the sleeve (115) of EP '194 does not teach that the magnets are intended to pivot in order to conform to the shape of the roof. The examiner disagrees since EP '194 discloses that sleeve (115) is made out of rubber and has a reduced cross-section (see figure 6) in the middle. Making the sleeve out of rubber and making the middle portion in a reduced cross-section allows the magnets to pivot/be spatially movable. Further, EP '194 suggests another way of pivotally attaching the magnets by stating that the permanent magnets 112 could be coupled with the aid of ball-and-socket joints.

The patent owner argues that the fastener of EP '194 does not project through the magnet, flexible sleeve, and into the base. The examiner disagrees since EP '194 shows in figure 6 that the fastener passes through the aperture in the magnet (112), the aperture in the sleeve (115) and into a portion of the base (114).

The patent owner argues that Mr. Halyard's opinion is evidence which is to be given considerable weight, just as the testimony of any expert witness is to be given weight in evidentiary proceeding. The examiner has considered the affidavit of Mr. Halyard. However, the examiner still maintains that the sleeve (115) of EP '194 allow the magnets to pivot slightly.

The patent owner argues that the element 14 of Podoloff is not a housing but instead is simply a resiliently deformable sleeve of generally annular shape. As broadly defined, the element (14) of Podoloff is considered to be a housing, i.e. the element (14) covers and protects the magnet.

The patent owner argues that EP '194 fails to show receptacles that extend along a portion of an adjacent side as defined in claim 14 and along a portion of an adjacent end as defined in claim 15. The examiner disagrees since the housing/receptacle (14) of EP '194 in view of Podoloff would extend along, i.e. near or adjacent, the sides and ends of the sign.

Conclusion

THIS ACTION IS MADE FINAL. While there is a stay of the concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed or suspended because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Feb. 21, 2006